In the Supreme Court of the United States

OCTOBER TERM, 1943

No. 468

THE [illegible] COMPANY,
Petitioner,
vs.
SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

REPLY BRIEF

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In the Supreme Court of the United States

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No. 169.

THE I. T. S. COMPANY,
Petitioner,

vs.

SEIBERLING RUBBER COMPANY,
and
THE SEIBERLING RUBBER COMPANY,
Respondents.

REPLY BRIEF FOR THE PETITIONER.

Now Comes the Petitioner and asks leave to file this Reply Brief and for its consideration by the Court.

POINT A.

The citations by Respondents constitute a saga of the confusion among the patent tribunals which the Commission deplores and seeks to remedy by its recommendation of the immediate adoption and use of the objective test.

The notations by Judge Hand in the *Kirsch* case, appearing at page 6 of Respondents' Brief, to the effect that the decision of the question of invention is "*to a large extent personal, and in that sense arbitrary*" is precisely the practice which the Commission says has led to the evil, for as long as the decision is personal, the decisions vary with the personalities and the personal views of the different tribunals. So long as the decisions are "arbitrary" they depart from reason and the right.

The unsoundness and the evil results of the present system discussed by Judge Hand are reflected in the text-

books. Thus at page 5 of Respondents' Brief, Respondents quote from *Walker on Patents,* one of the standard text-books on patent law, to the effect that the question of invention and mechanical skill—

> "cannot be answered by applying the test of any general definition."

It is this general definition which the Commission has supplied in recommending the objective test. What is needed is authority of this Court to apply that general definition.

The Commission repeated what Judge Hand and Walker have said when the Commission said:

> "Many different and unrelated tribunals now are forced to make their *individual* decisions, among them being the Patent Office, the several District Courts, the various Courts of Appeal and the Supreme Court."

Judge Hand's feelings are repeated by the Commission when the Commission said:

> "No other feature of the law is more destructive to the purpose of the patent system than this existing uncertainty as to the validity of the patent."

Judge Hand went on to say:

> "There is no affirmative rule by which to determine the presence or absence of invention in every case."

The Commission provides such a rule and has recommended the immediate adoption of the objective test for that purpose. Thus the Commission says:

> "There should be a uniformity in the grant and treatment of patents. The present confusion threatens the usefulness of the whole patent system and calls *for an immediate and effective remedy.*"

Respondents cite the decision of the Sixth Circuit Court of Appeals in *Trabon v. Dirkes* (136 Fed. (2) 24). This decision, in which resort was had to the objective test to determine the question of invention by a separate group of Judges from those who sat in the instant case (except

for Judge Simons), establishes either that the Court must have, in the *Trabon* decision, had the benefit of the Report of the Commission or else that the confusion on the subject which the Commission, Judge Hand, Walker, and others, have pointed out as current among all of the Patent Tribunals, is even current among different groups of Judges on the same Court of Appeals.

In behalf of the first conclusion it is to be noted that the decision in *Trabon v. Dirkes* was handed down June 4, 1943 and contains a reference to the Commission and its Chairman. The Report of the Commission was transmitted to Congress by President Roosevelt on June 18, 1943. That Court could not have had the views of the Commission when the decision in the instant case was rendered.

If the other conclusion is correct, then the confusion and diversity of views among the different sets of Judges on the same Court of Appeals is additional reason for granting our Petition in the instant case.

Respondents seem confused about the difference between the subjective test and the objective test, notwithstanding these two methods of reasoning and arriving at conclusions have been the subject of discussion not only throughout patent litigation for many years, but among philosophers and others with respect to general questions. The following excerpts from Webster's New International Dictionary (1931) are helpful, if not clarifying, on the subject:

> "The modern meanings of subjective (b above) and objective are mainly derived from the Kantian conception of the subject *of experience as the necessary condition of reality.*
>
> * * * * *
>
> "In the philosophy of the mind, subjective denotes what is to be referred to the thinking object, the ego; objective, what belongs to the object of thought, the nonego."

It at once becomes apparent that the subjective is personal and arbitrary, as Judge Hand characterized it in the *Kirsch* case, and the objective is predicated upon experience. The District Court in the instant case predicated his finding of the presence of invention upon evidence of experience and accepted the experience as the necessary condition of the reality, all outside of the ego, or personality. On the other hand, the Court of Appeals decided the question because the Court thought, as a matter of its indwelling views, that what was done was within the skill of the rubber workers. (The word "ego" used by the dictionary and by us is not used in the sense of vanity, of course, but in the sense of the person.)

An outstanding example is the decision of whether the world is flat or round which was presented to so many people in Ancient and Medieval times. Decided subjectively upon the basis of what the person or ego thought and saw with the eye, the earth was held to be flat. Decided upon the basis of the experience of people who had gone around the world and the experience of the astronomers, navigators and other scientists, the application of the objective test resulted in the decision that the world was round.

The sciences, the mechanics and invention are replete with such analogies, for the same thing might have been said about the question of whether the sun revolves around the earth or the earth turns in the face of the sun. The subjective test convinced the Ancients and people in the Middle Ages, and some people in the present day, that the sun moves around the earth. The objective test proves the error of this.

Another example is the "falling of the dew." Everybody was firmly convinced until recent times that "the dew falls." Yet the dew does not fall, notwithstanding the subjective test is convincing on the subject. Not only does the dew not fall, but the dew rises, as the objective test has shown and proved.

Many even more convincing examples are to be found in medicine. For a long time it was believed that many diseases, such as tuberculosis, were hereditary, and others, such as yellow fever, resulted from contact. These conclusions were necessarily based upon subjective tests. Investigation, experience, experiments, etc. have taught us the error of these subjective test conclusions, and through objective tests the truth has been learned. Once the truths were learned through objective tests, the medical profession was prompt and vigilant in rejecting the erroneous subjective test conclusions and adopting the correct objective test conclusions.

The number of such analogies is legion. We have cited these particular instances because they relate to more familiar subjects. If, of course, the question of the shape of the earth, the relation of the earth to the sun, and the source of the dew had continued to be decided on the subjective test, we would still have been morassed in the original errors. If the medical profession had persisted in adhering to subjective test diagnosis, we would still have been "dying like flies." There is no more reason why the question of invention should be continued to be decided upon the subjective test when the objective test is available than there is that we should continue to think the world is flat, the sun moves around the earth, the dew falls or to "die like flies." There is no reason in persisting in error when the truth is available. There is no more reason for persisting in the error and the confusion which the Commission points out, now that they have been hounded down and isolated by the Commission, than there would be in persisting in the errors regarding astronomy, meteorology and medicine to which we have referred.

The lengthy quotations in the Respondents' brief from the opinion of the Court of Appeals in the instant case are merely arguments and discussions of the Court leading up to the final and fatal conclusion that—

"it must have been perfectly obvious to those working in rubber."

This is a subjective test of subjective tests. Not only did the Court decide the question within the "ego," but the Court was not very certain about it, for the Court did not say that it was obvious to those working in rubber, which is the language generally used in the application of the subjective test, but the Court used the word "must," indicating uncertainty. It is also noted that the subjective test was not applied to the art to which the invention relates, but to the rubber art.

POINT B.

The mere fact that a part of the heel lift constituting the invention of the patent in suit is made of rubber does not make the shoemaker's art coincident with the rubber art.

It would be just as reasonable to contend that the steel-maker's art is identical with each of the arts in which steel is employed, including the printing press art, the agricultural machine art, the automatic screw machine art, the automobile art, etc., *ad infinitum*.

It would be just as reasonable to say that the tanner's art was identical with the arts in which leather is used, such as the shoe art, the belt art, the saddle art, the harness art, etc., *ad infinitum*.

It would be just as reasonable to say that the plastic art was identical with the innumerable arts in which articles are made of plastic.

In all of these cases the production of the material such as steel, rubber, leather and plastic are largely chemical or elemental otherwise, whereas the production of the articles from the materials is almost entirely mechanical. To take the position that there is identity between arts merely because one art involves the manufacture of a material used in the other art would result in almost as much

confusion and disaster as the use of the subjective test instead of the objective test, as the Commission points out, so that to cure the one and institute the other would be, to use a colloquial expression, "getting out of the frying pan into the fire."

POINT C.

There is nothing to the file wrapper estoppel claim. Neither Court below agreed with the Respondent's contention on the subject. Thus there are concurring opinions below rejecting it. Review thereof is not sought here.

POINT D.

Respondent's discussion emphasizes the impression made upon the District Court by the evidence upon which the objective test is based and the scant attention given this evidence by the Court of Appeals.

CONCLUSION.

The patent system has been, and is, a valuable entity, as the Commission has found.

This patient is sick, as the Commission has found, and as is established by the 28% decline in invention in this country in the last ten years to an all low per capita.

The President recognized that this valuable patient is sick and appointed the Commission to perform the function of the doctor to diagnose the case and to recommend a remedy.

This the Commission has done, adding that the remedy should be applied immediately.

In the medical profession, in the engineering profession, and in any other profession, the remedy would be applied forthwith.

Our Petition is an application that the law profession be as vigilant in applying remedies as any other profession.

Respectfully submitted,

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